

REMARKS

Applicant affirms the election of the Group I claims (1-32) and has cancelled the non-elected Group II claims (33-42) in the amendment presented above.

In the Office Action mailed October 2, 2006, claims 1-9 and 13-15 stand rejected under 35 USC 102(b) as being anticipated by U.S. Patent No. 6,228,063 to Aboul-Hosn (hereinafter "Aboul-Hosn"). Claim 10 stands rejected under 35 USC 103(a) as being unpatentable over Aboul-Hosn in view of U.S. Patent No. 5,330,497 to Freitas et al. (hereinafter "Freitas et al."). Claims 11-12 stand rejected under 35 USC 103(a) as being unpatentable over Aboul-Hosn in view of U.S. Patent No. 2,064,435 to Loeffler et al. (hereinafter "Loeffler et al."). Claim 16 stands rejected under 35 USC 103(a) as being unpatentable over Aboul-Hosn in view of U.S. Patent No. 5,423,796 to Shikhman et al. (hereinafter "Shikhman et al."). Claims 19 and 26-27 stand rejected under 35 USC 103(a) as being unpatentable over Aboul-Hosn in view of U.S. Patent No. 2,320,993 to Worner (hereinafter "Worner"). Claims 20-25, 28-30 and 32 stand rejected under 35 USC 103(a) as being unpatentable over Aboul-Hosn and Worner further in view of Freitas et al. Claim 31 stands rejected under 35 USC 103(a) as being unpatentable over Aboul-Hosn and Worner further in view of Shikhman et al.

Claim 1 has been amended to more particularly define the present invention over the cited prior art. More particularly, amended claim 1 recites, *inter alia*,

... wherein said flexible flange **has a frusto-conical shape with a proximally-concave outer surface that extends radially outward from**

the exterior surface of said tubular section in a proximal direction toward the proximal end of said tubular section, said outer surface being adapted to fold radially inward and toward the exterior surface of said tubular member during insertion of said port body through a narrow opening in the body wall to thereby reduce diameter of the flexible flange during such insertion (emphasis added).

Nowhere does the cited prior art teach or suggest these features.

The Examiner equates the lip structure 22 of Aboul-Hosn to the flexible flange of claim 1. This analysis is flawed. The lip structure 22 of Aboul-Hosn provides a concave surface that extends radially inward toward the penetrating member 72 and the interior surface of the cylindrical member 12 during insertion (FIG. 2A). After insertion, the lip structure 22 moves downward and then radially outward to form a proximally-convex sealing surface (FIG. 2B). In contrast, the flexible flange of claim 1 has “a frusto-conical shape with **a proximally-concave outer surface that extends radially outward from the exterior surface of said tubular section in a proximal direction toward the proximal end of said tubular section.**” The proximally concave outer surface of claim 1 does not extend radially inward as does the concave lip structure 22 of Aboul-Hosn. Moreover, claim 1 recites an “outer surface being adapted to fold radially inward and **toward the exterior surface** of said tubular member during insertion of said port body through a narrow opening in the body wall.” In contrast, the lip structure 22 of Aboul-Hosn extends radially inward toward the penetrating member 72 and **toward the interior surface of the cylindrical member 12** during insertion (FIG. 2A).

Because of these significant differences, Applicant respectfully submits that independent claim 1 as amended is patentable over the cited prior art.

Dependent claims 5-18 are patentable over the cited prior art for those reasons advanced above with respect to independent claim 1 from which they respectively depend and for reciting additional features neither taught nor suggested by the cited prior art. For example, claim 10 recites that “said retention member includes a pall that slides easily in a distal direction over said plurality of annular grooves and that resists sliding in a proximal direction by engaging one of said plurality of annular grooves.” Nowhere does the prior art teach or suggest these features.

Claim 19 is directed to a surgical port device including, inter alia,

... a port body including a tubular section having a distal end and a flange disposed at said distal end, **said flange having a frusto-conical shape with a proximally-concave outer surface and also having an annular projection that projects radially outward from said outer surface to provide a drip edge adapted to direct fluids around its periphery**
(emphasis added)

Nowhere does the cited prior art teach or suggest these features.

The Examiner points to the combination of Aboul-Hosn and Worner as suggesting this feature. The Examiner admits that Aboul-Hosn does not teach or suggest the annular projection of the claim but goes on to assert that it would be obvious to incorporate the annular skirt of the thermometer device of Worner as part of the surgical port device of Aboul-Hosn. The Examiner’s analysis is clearly flawed.

First, the alleged combination teaches away from the claim. More particularly, the skirt of the thermometer device of Worner is located in the intermediate section of the stem 6 of the instrument, not at the distal end of a tubular member as part of frusto-conical-shaped flange as recited in the claim.

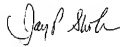
Second, the Examiner has not shown an incentive to combine the two references. With regard to the issue of incentive to combine, there must be some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references." In re Fritch, 23 USPQ2d 1780 (Fed. Cir. 1992) citing In re Fine, 5 USPQ2d 1596 (Fed. Cir. 1988) and In re Lalu, 223 USPQ 1257 (Fed Cir. 1984). The Examiner should note that the suggestion must be shown, not simply stated. If the suggestion cannot be shown in the references sought to be combined, the Examiner must show in some other reference that the knowledge suggesting the combination is generally available. It is not sufficient for the Examiner to simply state that general knowledge would support the proposed combination. In re Gal, 25 USPQ2d 1076 (Fed. Cir. 1992). It is respectfully submitted that there is no incentive to modify the Aboul-Hosn reference in any manner in accordance with the Worner reference in order to effectuate the claimed combination of elements.

For these reasons, any combination of Aboul-Hosn and Worner is improper.

The dependent claims 20-32 are patentable over the cited prior art for those reasons advanced above with respect to claim 19 from which they respectfully depend and for reciting additional features that are neither taught nor suggested in the prior art.

In light of all of the above, it is submitted that the claims are in order for allowance, and prompt allowance is earnestly requested. Should any issues remain outstanding, the Examiner is invited to call the undersigned attorney of record so that the case may proceed expeditiously to allowance.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Jay P. Sbröllini". The signature is fluid and cursive, with the first name "Jay" and last name "Sbröllini" clearly distinguishable.

Jay P. Sbröllini
Reg. No. 36,266
Attorney for Applicant(s)

GORDON & JACOBSON, P.C.
60 Long Ridge Road
Suite 407
Stamford, CT 06902
(203) 323-1800

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